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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/724,040 | 11/28/2000 | Manfred Boldy | DE919990090US1 | 6054 |

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EXAMINER

ABDULSELAM, ABBAS I

ART UNIT PAPER NUMBER

2674

DATE MAILED: 04/06/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,040

Applicant(s)

BOLDY, MANFRED

Examiner

Abbas I Abdulsalam

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In view of the appeal brief filed on 01/20/04, PROSECUTION IS HEREBY REOPENED as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Applicant's arguments with respect to claims 12-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop (USPN 5529415) in view of Goldman (USPN 6232960).

Regarding claims 12, 17 and 21, Bishop teaches a device (100) which contains a finger portion (12) having a rounded first end (14) and an open second end (16) with the second end adapted for removable securement to a fingertip (128) of a user. Bishop discloses that the finger portion has a ballpoint pen tip (24) secured to the open-end portion (22) outwardly extending of the rounded first end (14). See col. 3, lines 50-65 and Fig. 1. However, Bishop does not disclose an adhesive layer joined to the base surface of the dome for securing the dome. Goldman on the other hand teaches sensing devices (24), which can be affixed directly to the fingers using rubber cement or other fixative allowing subsequent removal of the sensing device. See col. 8, lines 40-43 and Fig. 1

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Bishop's fingertip pen writer system (Fig. 1) to adapt Goldman's use of rubber cement or other fixative material. One would have been motivated in view of the suggestion in Goldman that a rubber cement is functionally equivalent to the desired adhesive layer. The use of rubber cement helps function a data input device as taught by Goldman.

In addition, it would have been obvious for one of ordinary skill in the art to ascertain that Bishop's pen tip (24) can be used for the desired actuation of small keys on miniature keyboards.

Bishop also teaches that the device (10) can be in any variations in size, materials shape, form, function and the manner of operation. See col. 4, lines 23-37. Hence it would have been

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obvious that specific designs of the dome with axial opening and dimensions as well as symmetric rotational profile are met by bishop's teaching of variations in shape, size and form.

Regarding claims 13, 19 and 23, Bishop teaches a fingertip pen writer system as shown in Fig. 1 and inspection of the Fig. 1 reveals pen tip (24) contacting the surface in the same plane.

Regarding claims 14, 20, 25, Goldman teaches the sensing devices (24) with respect to cement or other fixative material, and it would have been obvious to utilize the adhesive contact on Bishop's device in any desired manner.

Regarding claim 15, Bishop teaches a point pen tip (24) used for writing and it would have been obvious that the tip is hard enough to be able to write on the surface.

Regarding claims 16, 18, 22, 24, Bishop teaches the use the device (10) with variations in materials shapes and forms.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following art is cited for further reference.

U.S. Pat. No. 6,454,808 to Masada

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Abbas Abdulsalam** whose telephone number is **(703) 305-8591**. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard Hjerpe**, can be reached at **(703) 305-4709**.

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Any response to this action should be mailed to:

Commissioner of patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314

Hand delivered responses should be brought to Crystal Park II, Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology center 2600 customer Service office whose telephone number is (703) 306-0377.

Abbas Abdulsalam

Examiner

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April 1, 2004


XIAO WU
PRIMARY EXAMINER